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IN THE

# Supreme Court of the United States

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No. 708

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October Term, 1946.

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CLARK & CLARK (a Corporation of New Jersey), CHARLES  
L. MORRIS, and ROBERT BRINTON MORRIS,  
Trading as PROFESSIONAL LABORATORIES,  
*Petitioners,*

*v.*

SMITH, KLINE & FRENCH LABORATORIES  
(a Corporation of Pennsylvania),  
*Respondent.*

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PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE THIRD CIRCUIT AND BRIEF IN  
SUPPORT THEREOF.

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**Supreme Court of the United States.**

October Term, 1946.

No. \_\_\_\_\_.

**CLARK & CLARK (A CORPORATION OF NEW JERSEY),  
CHARLES L. MORRIS, AND ROBERT BRINTON  
MORRIS, TRADING AS PROFESSIONAL LABORA-  
TORIES,**

*Petitioners,*

*v.*

**SMITH, KLINE & FRENCH LABORATORIES (A COR-  
PORATION OF PENNSYLVANIA),**

*Respondent.*

**PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE THIRD CIRCUIT.**

*To the Honorable, the Chief Justice and Associate Justices  
of the Supreme Court of the United States:*

Your petitioners respectfully pray for a writ of certiorari to the United States Circuit Court of Appeals for the Third Circuit to review the judgment of that Court entered in this case on August 6, 1946 (R. 325), modifying a judgment of the United States District Court for the District of New Jersey.

A petition for rehearing (R. 338) was filed in the Circuit Court of Appeals on September 26, 1946, and denied on October 17, 1946 (R. 359).

A certified transcript of the record in this case, including the proceedings in the Circuit Court of Appeals, is furnished herewith in compliance with Rule 38 of this Court.

**SUMMARY STATEMENT OF MATTERS INVOLVED.**

This is an action for patent infringement and unfair competition.

Respondent herein owns United States Patent No. 1,879,003 (R. 63) which describes two common salts—the sulphate and the hydrochloride—of a basic compound found by the courts below to have been known since 1887 (R. 329). The sole reference in the patent specification to the utility of the compounds is a single vague sentence to the effect that *the salts* “are physiologically active and produce effects in animals and man similar to the effect of the salts of ephedrine \* \* \*” (R. 63). The patent as issued contained two claims, the first of which respondent’s attorney conceded (R. 13) might “cover any and all of the salts” of the basic compound, and the second of which covered specifically the hydrochloride salt, one of the two salts described in the specification. Only the first claim is here in issue.

The Patent Office refused to allow any claims to the process of producing these salts on the ground that this process was “well known” (R. 75)—and so were the “physiological advantages and uses” of the salts—so all process claims were cancelled from the application.

Not only did the prior art describe the parent compound, from which the claimed salts were made, but, as found by the court below, it also described some of these salts, including the hydrochloride salt of claim 2 (R. 331). To save the claims from invalidation because they covered more than was proper, the patentee subsequently filed what he termed a disclaimer. In this disclaimer he admitted that the specification and claims of his patent were “too broad” and included that “of which he was not the first inventor” (R. 77). This so-called disclaimer, instead of striking the defective claims *in toto*, attempted to accomplish the purpose of a reissue by rewriting the patent claims. In addition it redirected the claims to whatever salts might happen to have the desired functional prop-

erties,<sup>1</sup> as is evident from the following comparison of original claim 1 with the disclaimer (R. 66):

*Original Claim 1:*

“As a new composition of matter, a salt of 1-phenyl-2-aminopropane.”

*The disclaimer:*

“disclaims so much of claim 1 of said patent as is in excess of the following: ‘As a physiologically active therapeutic agent capable of producing effects in animals and man similar to the effect of salts of ephedrine, a salt of 1-phenyl-2-aminopropane.’ ”

During the following years, independent investigators in the field of psychoneuroses found that the sulphate salt of 1-phenyl-2-aminopropane (commonly referred to as amphetamine sulphate) had a pronounced and highly beneficial effect on the central nervous system.<sup>2</sup> This was the second salt described in the patent at bar, but no claim had been specifically directed to it.

When the valuable therapeutic properties of amphetamine sulphate became known respondent purchased this patent and commenced to manufacture and sell this product under the trade name “Benzedrine Sulphate.” It was sold in the form of round tablets which could be broken into four equal doses. For this purpose it had bevelled edges, a concave bottom and crossed grooves on the upper face. The tablets were white since that is the color of the salt. Both of the lower courts held that these features of the tablet were “functional in their totality” (R. 314, Finding 80; R. 333).

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<sup>1</sup> The specification failed to state which salts had the desired functional properties and which did not.

<sup>2</sup> This effect is diametrically opposite to the ephedrine-like effect predicted by the patent, which is of benefit only to the *sympathetic* nervous system but is detrimental to the central nervous system (R. 308, Finding 49).

Some years after respondent commenced the sale of these tablets petitioners began to manufacture and sell amphetamine sulphate in a tablet of similar appearance. Photographs of petitioners' and respondent's tablets appear at pages 67 and 295 of the record. Petitioners' tablets were sold under the trade name "Profetamine" in labelled containers which concededly bear no resemblance to those of respondent. Respondent was obtaining \$22.00 per thousand for its tablets, whereas petitioners' tablets of equally good quality sold for less than \$10.00 per thousand.

These tablets are sold only on prescription, and all sales by respondent and petitioners are to doctors or druggists (R. 311, Finding 62). It is conceded that no doctor or druggist purchased petitioners' tablets for those of respondent. However, respondent contends, on the basis of highly speculative evidence, that some druggists have substituted petitioners' tablets on prescriptions calling for respondent's "Benzedrine Sulphate."<sup>3</sup> Petitioners never suggested that their tablets might be substituted for those of respondent, but it was held that the similarity of the tablets was "auto-suggestive" (R. 315, Finding 84).

On the patent phase of the case, the District Court, in a lengthy opinion, held that the discovery of new uses for old compounds should not be discouraged by a holding of unpatentability (R. 135). The patent was thereupon held to cover the compound "as a therapeutic agent whenever it produces effects similar to the effects of salts of ephedrine" (R. 137).—Query, when the same compound is used for some other purpose is it covered by the patent?—The patent was held valid and infringed. On the unfair competition count, the District Court, while holding that all the features of the tablets were "functional in their

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<sup>3</sup> Respondent has a direct remedy against any druggist who improperly fills prescriptions for its product—*Winthrop Chemical Co. v. Weinberg* (3 Cir., 1932), 60 F. (2d) 461—but it has failed to exercise this right.



totality," nevertheless gave to respondent a perpetual monopoly on these features, because they imparted to respondent's tablet "a distinctive appearance" (R. 176).

The Circuit Court of Appeals held the patent valid and infringed, but by an approach quite unlike that of the District Court. It held that the disclaimer limited the patent to "effects" which would "destroy" it (R. 327). To avoid invalidating the patent it then ignored the disclaimer *in toto* (R. 328). This left claim 1 so broad that it should still have been invalidated (R. 328). But the Court avoided this dilemma by judicially rewriting the claim to exclude from its scope all the numerous amphetamine salts with the exception of the one compound described in the specification which was of commercial importance (R. 329, 331). By this approach the Circuit Court of Appeals affirmed the judgment of the District Court on the patent count.

On the unfair competition count the Circuit Court of Appeals modified the judgment of the District Court by properly holding that since the distinctive features of respondent's tablets were functional petitioners had the right to copy them (R. 333). However, it then defeated the effect of this holding by placing upon petitioners the obligation and expense of distinguishing their tablets from those of respondent by imprinting thereon their initials or similar identifying marks (R. 336). For all practical purposes this still left respondent with a permanent monopoly on the functional features of its tablets because, as found by the Court of Appeals, doctors will not prescribe tablets which bear marks indicating that they are a patent medicine (R. 333, footnote).

Respondent has granted but one license under the patent at bar, and the licensee is obligated to manufacture the patented chemical compound "for veterinary use only" (R. 87). Purchasers from this licensee are likewise restricted in the use which they can make of the product. They must incorporate it in "veterinary medicine" (R. 358, footnote). This is a misuse of the patent which dur-

ing its continuance should bar respondent from obtaining any relief from the courts. Yet the Circuit Court of Appeals refused to penalize respondent for this attempt to expand its patent monopoly by controlling the use of the patented product in the channels of trade. In effect, respondent is being assisted in its misuse of this patent by a judicial decree which prevents competition.

### **JURISDICTIONAL STATEMENT.**

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925, Ch. 229 (28 U. S. C. Sec. 347).

The final decree of the Circuit Court of Appeals was entered on August 6, 1946 (R. 325), and the petition for rehearing was denied on October 17, 1946 (R. 359).

### **THE QUESTIONS PRESENTED.**

1. Can a patent disclaimer be ignored in order to sustain the patent?

2. Where a claim is so broad and indefinite that it is invalid can it be redrafted by the court to restrict it to a single compound of commercial importance which is described in the specification but not mentioned in the claim?

3. Where the process of making a chemical compound is well known and unpatentable is a claim to that compound valid?

4. Can a manufacturer who adopts functional features for a tablet prevent a competitor from later employing the same features unless he incurs the expense and sales handicap of adding initials or other distinguishing marks to his competitive tablets?

5. Where a patent owner restricts the use which purchasers can make of the patented product is this an improper expansion of the patent monopoly which bars judicial relief?

**REASONS RELIED ON FOR THE ALLOWANCE  
OF THE WRIT.**

1. The Circuit Court of Appeals for the Third Circuit in deciding this case has established unique precedents of far-reaching importance in the field of chemical patent law and unfair competition.

2. This decision is believed to be diametrically contrary to several controlling decisions of this Court.

3. In addition, it is in conflict with decisions of the Circuit Court of Appeals for the Second Circuit on the same matters.

4. Respondent has filed the following additional suits for infringement of the patent at bar, and some of these suits also include the same unfair competition issue as is present herein, although none has yet gone to trial:

1. *Smith, Kline & French Laboratories v. Organic Products Co. et al.*, filed July 16, 1942, in the U. S. District Court for the Southern District of New York;
2. *Smith, Kline & French Laboratories v. R. S. A. Corp. et al.*, filed August 7, 1942, in the U. S. District Court for the Southern District of New York;
3. *Smith, Kline & French Laboratories v. Benjamin Zirin*, filed August 17, 1942, in the U. S. District Court for the Eastern District of New York;
4. *Smith, Kline & French Laboratories v. Lannett Co. et al.*, filed August 26, 1942, in the U. S. District Court for the Eastern District of New York;
5. *Smith, Kline & French Laboratories v. Pro-Medico Laboratories, etc., et al.*, filed January 3, 1944, in the U. S. District Court for the Eastern District of New York;
6. *Smith, Kline & French Laboratories v. Ziegler Pharmacal Co.*, filed April 19, 1945, in the U. S. District Court for the Western District of New York;

7. *Smith, Kline & French Laboratories v. Rona Pharmaceutical Co.*, filed April 30, 1945, in the U. S. District Court for the Eastern District of Pennsylvania;
8. *Smith, Kline & French Laboratories v. Gamma Pharmaceutical Co. et al.*, filed June 26, 1945, in the U. S. District Court for the Northern District of Illinois;
9. *Smith, Kline & French Laboratories v. National Drug Laboratories, Inc. et al.*, filed June 26, 1945, in the U. S. District Court for the Northern District of Illinois;
10. *Smith, Kline & French Laboratories v. David M. Grossmann*, filed August 30, 1945, in the U. S. District Court for Massachusetts.

While respondent has procured, by one means or another, consent decrees in some of these cases, others are still pending. The final determination of the issues in this case will therefore avoid a multiplicity of suits during which the medical profession and the druggists will continue to be threatened and intimidated by respondent, to the ultimate damage of those members of the public who require amphetamine sulphate for the treatment of their ills.

WHEREFORE, your petitioners respectfully pray that a writ of certiorari be issued to the United States Circuit Court of Appeals for the Third Circuit to the end that this case may be reviewed and determined by this Court; that the judgment of the Circuit Court of Appeals be reversed; and that petitioners may be granted such other and further relief as may be proper.

CLARK & CLARK, CHARLES L. MORRIS,  
AND ROBERT BRINTON MORRIS, TRADING  
AS PROFESSIONAL LABORATORIES,

By ARTHUR G. CONNOLLY,  
*Counsel.*

November 21, 1946.

## **BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.**

### **Opinions of the Courts Below.**

The opinion of the District Court, written by Judge Forman, appears at page 91 of the record and is reported in 62 F. Supp. 971.

The opinion of the Circuit Court of Appeals (Circuit Judges Biggs and O'Connell and District Judge Gourley), written by Judge Biggs, appears at page 325 of the record and is reported in 70 USPQ 382; but it has not yet appeared in the official reports.

### **Jurisdiction.**

The jurisdictional statement appears in the accompanying petition.

### **Statement of the Case.**

The essential facts of the case are stated in the accompanying petition and need not be repeated here.

### **Specification of Errors.**

The Circuit Court of Appeals for the Third Circuit erred:

1. In ignoring a patent disclaimer which it conceded would "destroy" the claim.
2. In sustaining a claim which the patentee admitted was "too broad" and included that "of which he was not the first inventor".
3. In judicially redrafting a broad claim to exclude from its scope everything but a single compound of commercial importance which was described in the specification but not referred to in the claim.

4. In sustaining a claim to a chemical compound when the Patent Office had held the process for its production to be "well known" and unpatentable, and the patent showed on its face that it involved only the most elementary reaction in chemistry, i. e., neutralization of a base with an acid.

5. In refusing to permit a competitor to copy the functional features of a tablet unless such features were coupled with additional distinguishing marks.

6. In granting relief to a party who is misusing its patent monopoly to control the use of the patented product in the hands of purchasers.

### **Summary of Argument.**

In *Altoona Public Theatres, Inc. v. American Tri-Ergon Corp.* (1935), 294 U. S. 477, 492, this Court held that a disclaimer cannot be ignored, even when it is improperly used. Yet, because the disclaimer herein was improper and destroyed the claim the Circuit Court of Appeals ignored it (R. 327-8).

Having ignored the disclaimer, the Circuit Court of Appeals had before it the original claim which the patentee had admitted was "too broad" and included that "of which he was not the first inventor" (R. 77). The Court, furthermore, found this claim to be vague and indefinite, and to embrace both inoperative compounds and prior art compounds (R. 328-9). But to sustain the patent it circumvented these difficulties by judicially redrafting the claim to exclude everything except a single compound mentioned in the specification but not referred to in the claim (R. 329). This is contrary to the controlling authority of *General Electric Co. v. Wabash Co.* (1938), 304 U. S. 364, 369, and *United Carbon Co. v. Binney Co.* (1942), 317 U. S. 228, 236, which hold that a claim is invalid if it does not accurately define the invention and clearly distinguish it from the prior art. It is also contrary to the *Altoona* case, *supra*, which holds (p. 487) that a claim cannot be saved by reading into

it parts of the specification which the patentee failed to include in it.

In *General Electric Co. v. Jewel Incandescent Lamp Co.* (1945), 326 U. S. 242, 248, this Court held that if the method of manufacturing an article is known the article cannot be patented even though a new advantage is discovered for it. The process of making the compound covered by the patent at bar was held by the Patent Office to be "well known" and unpatentable (R. 75). The patentee acquiesced in this holding by cancelling all process claims from his application. Yet, the Circuit Court of Appeals sustained a claim to this compound.

In *Warner & Co. v. Lilly & Co.* (1924), 265 U. S. 526, 528, and *Kellogg Co. v. National Biscuit Co.* (1938), 305 U. S. 111, 121; this Court held that functional features of a product cannot be permanently monopolized as a trademark. The Circuit Court of Appeals acknowledged that there could be no unfair competition in copying the functional features of a competitor's tablet (R. 333). Yet, it thereafter defeated the effect of this holding by placing upon petitioners the obligation and expense of distinguishing their tablets from those of respondent (R. 336).

In *Motion Picture Patents Co. v. Universal Film Mfg. Co.* (1917), 243 U. S. 502, 516, and *Boston Stores of Chicago v. American Graphophone Co.* (1918), 246 U. S. 8, 25, this Court held that when a patented article is sold it passes beyond the confines of the patent law and cannot thereafter be controlled by the patentee. Respondent herein has obligated purchasers of the patented product to use it only in veterinary medicine (R. 87; 358). This is an attempt to expand the patent monopoly and control the product in the channels of trade, which should bar all judicial relief, under the doctrine of *Mercoïd Corp. v. Mid-Continent Investment Co.* (1944), 320 U. S. 661, 670, and cases cited therein. Yet the Circuit Court of Appeals refused to penalize respondent for this misuse of its patent—which is still continuing while respondent takes advantage of the judicial processes to implement it.

**ARGUMENT.****Point I.****The Circuit Court of Appeals Erred in Ignoring a Patent Disclaimer.**

It is settled that a patent disclaimer cannot be ignored, even when it is improperly used, because it irrevocably abandons the original claim. In *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.* (1935), 294 U. S. 477, this Court held (p. 492):

“With the invalid disclaimer must fall the original claims as they stood before the disclaimer. The disclaimer is a representation, as open as the patent itself, on which the public is entitled to rely, that the original claim is one which the patentee does not, in the language of the statute, ‘choose to claim or hold by virtue of the patent.’ Upon the filing of the disclaimers, the original claims were withdrawn from the protection of the patent laws, and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned. To permit the abandoned claim to be revived, with the presumption of validity, because the patentee had made an improper use of the disclaimer, would be an inadmissible abuse of the patent law to the detriment of the public.”

In the case at bar the Circuit Court of Appeals held (R. 327) that the disclaimer limited the claims to “effects”, which would “destroy Alles claim 1” because a patent cannot claim effects.<sup>4</sup> Under the controlling authority of *Al-*

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<sup>4</sup> It is doubtful whether a disclaimer can be used for any purpose other than to cancel the defective claim *in toto*. This seems to be the holding of this Court in the *Altoona* case, *supra*, at pages 490-91; and to the same effect is *Milcor Steel Co. v. George A. Fuller Co.* (1942), 316 U. S. 143, 148. This was stated to be the import of the foregoing



*toona v. Tri-Ergon, supra*, this holding required that the patent be invalidated. Instead of holding the patent invalid, however, the Circuit Court of Appeals ignored the disclaimer completely and held (R. 327-8):

“We think that it would be unfair to destroy Alles’ claim 1 because he has claimed effects by his disclaimer \* \* \* But since Alles may not claim effects, claim 1 must stand precisely as printed in the [original] patent, viz., ‘As a new composition of matter, a salt of 1-phenyl-2-aminopropane.’” [The original claim freed of the restrictive disclaimer.]

It is believed self-evident that in ignoring the disclaimer to sustain the patent at bar, the Circuit Court of Appeals decided a federal question in a manner which conflicted with the applicable decision of this Court. Having found that the disclaimer improperly directed the claim to effects, and thereby destroyed it, the court below was bound to invalidate the patent.

### Point II.

#### **The Circuit Court of Appeals Erred in Sustaining a Claim Which the Patentee Admitted Was Too Broad and Included That of Which He Was Not the First Inventor.**

When the patentee filed his disclaimer in the Patent Office he included therein the statement that the claims of the patent at bar were “too broad” and included “that of which he was not the first inventor” (R. 77).—As found by the court below, the prior art described the base, amphetamine (R. 329), and also some of its salts (R. 331).—Having disregarded the disclaimer, the Circuit Court of Appeals

decisions in *Foxboro Co. v. Taylor Instrument Companies* (2 Cir., 1946), 70 USPQ 338, 344. In the case at bar, however, the courts below have approved so-called “interpretative disclaimers” which summarily rewrite the defective claims and thereby avoid application for a reissue patent.

had before it for adjudication a claim which covered the prior art. It should, therefore, have been invalidated. But to save this claim the court below judicially redrafted it to exclude from its scope everything but a single compound of commercial importance which was described in the specification but not referred to in the claim (R. 329).

In *Altoona Publix Theatres v. American Tri-Ergon, supra*, this Court condemned the practice of judicially redrafting a claim by reading into it details of the specification, holding (p. 487):

“As none of the flywheel claims as drawn define an invention, none can be aided by reading into it parts of the specifications, \* \* \* which the patentees failed to include in it.”

The foregoing holding of the Circuit Court of Appeals is also in conflict with a recent decision of the Circuit Court of Appeals for the Second Circuit on the same matter. In *Foxboro Co. v. Taylor Instrument Co.* (2 Cir. 1946), 70 USPQ 338, 343, it was held:

“\* \* \* We should have no warrant for limiting the claims by the elements of the disclosure which they do not include, even if the elements were new. A patentee who claims broadly must prove broadly; he may not claim broadly, and recede as he later finds that the prior art unknown to him has limited his invention. This is the chance he must take in making broad claims; \* \* \*.”

### Point III.

#### **The Circuit Court of Appeals Erred in Judicially Redrafting the Claim to Avoid Its Additional Defects.**

The court below *expressly* held that the patent claim in issue is defective in each of the following respects:

(a) It does not accurately define the invention (R. 327):

"It is very difficult to evaluate the patent or to determine the impact of the disclaimers on the claims. The fact is that Alles by his specification and by his disclaimers claims *effects*. \* \* \* A patentee may not claim effects for a new composition of matter. \* \* \*

(b) It does not clearly designate the claimed compounds (R. 328):

"Alles, however, has not designated any particular salt of amphetamine in claim 1. \* \* \*

(c) It embraces amphetamine salts which are inoperative (R. 328):

"His specification states that 'Various acids may be used [to create the salt] \* \* \*.' Interpreting this language (as well as that employed in the disclaimers), the conclusion is inevitable that salts created by the reaction of some acids with amphetamine will have the ephedrine-like quality asserted by Alles but that other salts created by the reaction of other acids with amphetamine will not create salts which will work the desired effect. \* \* \*

(d) More than experimentation is necessary to determine the limits of the claim (R. 328):

"\* \* \* Since effects may not be claimed, not even experimentation, prohibited by R. S. Section 4888, 35 U. S. C. A. Sec. 33, would serve to designate the salts which Alles has claimed in claim 1. \* \* \*

There should, therefore, be no doubt that this claim is invalid because it fails to meet the required standard of specificity laid down by this Court in *General Electric Co. v. Wabash Co.* (1938), 304 U. S. 364, and *United Carbon Co. v. Binney Co.* (1942), 317 U. S. 228. In the *General Electric* case this standard was stated as follows (p. 369):

“ \* \* \* Congress requires of the applicant ‘a distinct and specific statement of what he claims to be new, and to be his invention.’ Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirements as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the insurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others rising from uncertainty as to their rights. The inventor must ‘inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.’ The claims ‘measure the invention.’ \* \* \* In a limited field the variant must be clearly defined.”

The foregoing standard was further implemented in the *United Carbon* case (pp. 236-7):

“The statutory requirements of particularity and distinctness in claims is met only when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise. A zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field. Moreover, the claims must be reasonably clear-cut to enable courts to determine whether novelty and invention are genuine. \* \* \* An invention must be capable of accurate definition, and it must be accurately defined, to be patentable.”

Under the controlling authority of the foregoing decisions invalidation of the defective claim at bar would

appear to be inevitable. But instead of invalidating the claim, the Circuit Court of Appeals completely redrafted it, to make it specific; to eliminate its reference to effects; to exclude inoperative compounds; to exclude the prior art; and to avoid the necessity of experimentation. To accomplish all this the court below adopted what it termed an "alternative construction" (R. 328). Actually this "construction" rewrote the claim, so that instead of claiming "all salts of amphetamine without regard to their effects" (R. 328), as the court conceded was called for by its language, it covered only the single compound, amphetamine sulphate, which is nowhere referred to or defined in the claim (R. 329; 331).

The manner in which the Circuit Court of Appeals has rewritten the claim at bar is also in conflict with a recent opinion of the Circuit Court of Appeals for the Second Circuit on an almost identical fact situation. In *Schering Corporation v. Gilbert* (2 Cir., 1946), 153 F. (2d) 428, 433, a claim to a broad class of therapeutically useful chemical compounds was held invalid because it went far beyond the examples of the specification and required further experimentation to determine which of the claimed compounds had the desired therapeutic properties. Yet, the patent specification in the *Schering* case was much more complete and informative than that of the patent at bar.

The Circuit Court of Appeals in this case is believed to have promulgated a new doctrine of patent law to the effect that although a patent claim is vague and indefinite, goes far beyond the specification, covers inoperative compounds and prior art compounds, and requires experimentation to ascertain its limits, if one of the examples of the specification describes a compound of importance the patent will be sustained by a so-called "alternative construction" which completely rewrites the claim to restrict it to that compound. This invites the patentee to seek the broadest claim possible, because if he gets into difficulty subsequently his claim will be redrafted by the court to

eliminate its defects and redirect it to whatever specific compound of commercial importance may be described in the specification. The fact that the patentee could have—and should have—claimed this specific compound initially, instead of the broad class, is disregarded. The uncertainty and risk to which the public is subjected by this practice is likewise disregarded.

It is submitted that this doctrine is at complete variance with the applicable decisions of this Court.

#### **Point IV.**

#### **The Circuit Court of Appeals Erred in Sustaining a Claim to a Compound When the Method of Manufacturing It Was Well Known.**

During the prosecution of the application for the patent at bar claims were presented for the process of making the described salts. The Patent Office rejected these claims on the ground that (R. 75):

“It is well known (see any organic textbook) that amines, in general, form salts with mineral acids \* \* \*.”

The patentee conceded the soundness of this rejection by cancelling all claims to this process. According to the patent specification, this process involves merely the neutralization of a base with an acid (R. 64-5). Although this is the most elementary reaction in chemistry, the Circuit Court of Appeals held the resulting product to be patentable.

This is contrary to the applicable ruling of this Court in *General Electric Co. v. Jewel Incandescent Lamp Co.* (1945), 326 U. S. 242, 248, which holds:

“\* \* \* The principle of the *Ansonia* case plainly would deny validity to the Pipkin patent if the prior art disclosed an electric bulb so frosted on the inside as to round out the angular crevices produced by the first etching, whether the full utility of the bulb had been previously recognized or not. The same result

is indicated where, as in the present case, the prior art discloses the method of making an article having the characteristics of the patented product, though all the advantageous properties of the product had not been fully appreciated. \* \* \* Where there has been use of an article or where the method of its manufacture is known, more than a new advantage of the product must be discovered in order to claim invention."

It is submitted that since the method of manufacturing the salts of the patent at bar was well known and unpatentable, these compounds likewise are unpatentable.

**Point V.**

**The Circuit Court of Appeals Erred in Refusing to Allow Competitors to Copy the Functional Features of a Tablet Unless They Added Distinguishing Marks to It.**

Both the District Court (R. 314, Finding 80) and the Circuit Court of Appeals (R. 333) held that every feature of respondent's tablet was functional. Under the controlling authority of *Warner & Co. v. Lilly & Co.* (1924), 265 U. S. 526, 528-31, and *Kellogg Co. v. National Biscuit Co.* (1938), 305 U. S. 111, 121, functional features of a product are in the public domain and every competitor has the right to make free use of them.

The Circuit Court of Appeals properly held that (R. 333):

"\* \* \* Even if the accused tablets had been exact copies of SKF's tablets, the so-called distinctive features of SKF's tablets upon which it relies would none the less be functional. It follows that SKF's contention that the defendants, in copying the features of its tablets were guilty of unfair trade practice, must fall \* \* \*."

But it thereafter defeated the purpose of this holding by placing upon petitioners the obligation and expense of adding "some other distinguishing mark" to their tablet (R. 336). This gave to respondent in perpetuity an unfair

competitive advantage since it was spared the expense of including any distinguishing marks on its tablets. Furthermore, for all practical purposes this also gave to respondent a perpetual monopoly on the functional features, as doctors will not prescribe a tablet which bears a mark indicating that it is a patent medicine rather than a specially compounded prescription (R. 333, footnote).

If the functional features of an article may be permanently withdrawn from the public domain by the first manufacturer who spends sufficient money to popularize them, it will not be long before less affluent competitors will be driven out of business. Whether competitors are forbidden to employ these features at all, or must incur the expense and sales handicap of including additional distinguishing marks is immaterial.

It is submitted that the functional features of a product must remain in the public domain, and must be freely available to all competitors.

#### **Point VI.**

#### **The Circuit Court of Appeals Erred in Granting Judicial Relief to a Patent Owner Who Was Misusing the Patent.**

Respondent has granted one license under the patent at bar, but the licensee is required to distribute the patented product for use only in the veterinary field (R. 87). Respondent likewise controls the use which purchasers may make of the patented product, requiring them to use it "in veterinary medicine" (R. 358, footnote). Although these purchasers have bought and paid for the patented product they are not free to use it as they please. It is still under the control of the patent owner, despite the fact that title has passed and the patent owner has received everything to which he is entitled under the patent law. The patent owner has no more right to control the use of the product in the hands of a purchaser than he has to fix its resale price, or to require its use with specified unpatented materials—all of which practices are illegal.



In *Motion Picture Patents Co. v. Universal Film Mfg. Co.* (1917), 243 U. S. 502, 516, and *Boston Stores of Chicago v. American Graphophone Co.* (1918), 246 U. S. 8, 25, this Court held that when a patented article is sold it passes beyond the confines of the patent law. Any attempt thereafter to control the use of the product in the hands of a purchaser, under the guise of a patent license, is improper. The patent monopoly is—and should be—exhausted when title to the patented article passes.

Since respondent has abused the patent privilege by attempting to control the use of the patented product throughout the channels of trade, it is precluded from judicial relief. *B. B. Chemical Co. v. Ellis* (1942), 314 U. S. 495, 498; *Mercoind Corporation v. Mid-Continent Investment Co.* (1944), 320 U. S. 661, 670.

### CONCLUSION.

The decision of the Circuit Court of Appeals in this case involves several propositions of fundamental importance in the field of chemical patents and unfair competition. These propositions have been decided in a manner which is believed to be contrary to the applicable decisions of this Court, and in conflict with the decisions of the Circuit Court of Appeals for the Second Circuit on the same matters.

We respectfully request the Court to grant this petition in order that it may resolve the conflict of decisions, with the inevitable confusion resulting therefrom, and correct the errors of the court below.

Respectfully submitted,

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